

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 2-10, 13-17 and 20-30 are now present in this application. Claims 2, 4, 7, 8, 10, 13, 14, 20 and 29 are independent.

Reconsideration of this application is respectfully requested.

Claims 20-28

Claims 20-28 have been withdrawn from further consideration. Should currently rejected claims 2-6, 8-1 and 30 be allowed, Applicant hereby authorizes the Examiner to cancel withdrawn claims 20-28 to place the Application in condition for allowance. Applicant also reserves the right to file a divisional patent Application with respect to the subject matter of claims 20-28.

Rejections under 35 U.S.C. § 103

Claims 2, 3, 5, 6 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Welch in view of U.S. Patent 6,778,081 to Matheny. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Because the rejection is based on 35 U.S.C. § 103, what is in issue in such a rejection is “the invention as a whole,” not just a few features of the claimed invention. Under 35 U.S.C. § 103, “ [a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” The determination under §103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O’Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the invention must be considered as a whole and the claims must be considered in their entirety. See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1567, 220 USPQ 97, 101 (Fed. Cir. 1983).

In rejecting claims under 35 U.S.C. § 103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta

Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Moreover, it is well settled that the Office must provide objective evidence of the basis used in a prior art rejection. A factual inquiry whether to modify a reference must be

based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Furthermore, during patent examination, the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the Applicant is entitled to the patent. Only when a *prima facie* case is made, the burden shifts to the applicant to come forward to rebut such a case.

Initially, Applicant respectfully submits that, because Welch discloses such a comprehensive system, if providing the recited features set in claim 3 were obvious, then Welch would have thought of doing so, and disclosed such features in the Welch patent application, when the application was filed in 1992. However, Welch is totally silent in this regard. This is an indication that Applicant's claimed combination of features is not obvious to one of ordinary skill in the art.

Claim 2 positively recites a combination of features wherein each of said plurality of speakers is volume controlled to be independently adjusted to cause the audible alarm to have a substantially constant volume level throughout a specified work area of the building. This combination is not disclosed by Welch. Welch never addresses this subject matter and, instead relies on annunciators that combine sound and a message – see col. 6, lines 1-15, for example. Applicant is unable to find in Welch, a disclosure that each of said plurality of speakers is volume controlled to be independently adjusted to cause the audible alarm to have a

substantially constant volume level throughout a specified work area of the building, as recited.

In an attempt to remedy this deficiency of Welch, the Office Action turns to Matheny, col. 3, lines 31-37. The Office Action indicates that Matheny discloses, in a related art, a zoned alerting control system wherein a plurality of speakers are volume controlled to be independently adjusted to cause an audible alarm to have a substantially constant volume level throughout a specified work area of a building as desired.

Applicant respectfully disagrees and submits that Matheny merely discloses, in the relied upon col. 3, lines 31-37, that it mounts a dorm remote device next to each bed in a firehouse dormitory that “emits dispatch audio awakening only the personnel needed for the call.” The features of the remote include adjustable volume levels and programmable zone control. Matheny also discloses that its system provides a dorm remote device for each bed (col. 3, lines 1-2). Matheny’s stated object is to “alert only selected personnel for a particular type of emergency, i.e., fire, medical, etc. to decrease response time while reducing stress to remaining personnel who need not be alerted.” See the Abstract.

Matheny only discloses generic volume control of individual speakers, which are activated selectively to awaken only certain personnel in the firehouse. Matheny does not disclose that each of said plurality of speakers located at various different spaced-apart areas within the building is volume controlled to be independently adjusted to cause the audible alarm to have a substantially constant volume level throughout a specified work area of the building, as recited in claim 2. So, even if it one of ordinary skill in the art were properly

motivated to turn to Matheny to modify Welch, the resultant modification of Welch would not result in, or otherwise render obvious, the claimed invention.

Moreover, Applicant respectfully submits that one of ordinary skill in the art would not be properly motivated to modify Welch in view of Matheny in this regard at all because of the significant differences between these two references. In this regard, Welch's system deals with monitoring of patients who individually activate alarms, whereas Matheny does not monitor individually activated alarms but does just the opposite, i.e., centrally activates alarms to selectively alert individual firefighters.

Applicant also respectfully submits that one of ordinary skill in the art would have no incentive to incorporate the zoned alerting system of Matheny into Welch because they are at cross purposes, Welch monitoring alerts at a central location from many patients while Matheny does just the opposite, i.e., alerts many individuals from a central location.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Further, with respect to claim 30, the Office Action does not explain what one of Matheny's zones not being alerted and a different zone being alerted has to do with the claimed invention, i.e., where each of said plurality of speakers is volume controlled to be independently adjusted to cause the audible alarm to have a substantially constant volume level throughout a specified work area of the building. In fact, not activating an alarm in one zone would appear to accomplish just the opposite of what is claimed, i.e., instead of creating a substantially constant volume throughout a specified work area of the building, Matheny

appears to create one or more loud noises in one part of an area while not creating any noise in another part of that area.

Claims 4 and 8-10 stand rejected under 35 USC § 103(a) as being unpatentable over Welch in view of Matheny, as applied in the rejection of claim 2, and further in view of U.S. Patent 6,784,797 to Smith et al. ("Smith"). This rejection is respectfully traversed.

Initially, applicant respectfully submits that claims 4 and 8-10 do not recite the subject matter of claim 2 for which Matheny was applied in the rejection of claim 2, i.e., claims 4 and 8-10 do not recite each of said plurality of speakers is volume controlled to be independently adjusted to cause the audible alarm to have a substantially constant volume level throughout a specified work area of the building.

For this reason alone, the rejection is improper and should be withdrawn.

Further, with respect to claim 4, Welch does not disclose or suggest that the audible alarm is provided with several different tones, volumes, chimes and sounds, as recited, and with respect to claims 8-10, Welch clearly does not disclose or suggest the recited pitch or tone changes, or increase in volume over time as the audible alarm continues.

In an attempt to remedy the deficiencies in Welch and Matheny, the Office Action turns to Smith, which discloses a bed patient monitor and contains a statement in col. 23, lines 7-15, that "the term 'digital synthesis' as used in the context of generating alarm sounds, should be interpreted in its broadest sense to include any sort of sound that is generated by the PLDS (programmable logic devices) under software control." Examples

discussed by Smith are “something as complex as playing a “MIDI” file or an MP3 or other digital sound file (e.g., a WAV file, a .SND file, etc.) through the loudspeaker or as simple as repeatedly turning the speaker “on” or ‘off’ under microprocessor control to create a sound.”

Nowhere in the relied upon portion of Smith, does Smith disclose (1) that the audible alarm is provided with several different tones, volumes, chimes and sounds, as recited in claim 4, or (2) that the recited pitch or tone changes, or increase in volume over time as the audible alarm continues, as recited in claims 8-10.

Applicant respectfully submits that this rejection that relies on a generic disclosure of a large number of unspecified sounds to render obvious a particular combination of different specific sounds (claim 4) and of claimed pitch or tone changes or increase in volume over time as the alarm continues (claims 8-10) simply does not disclose or suggest or otherwise render obvious these specific claimed features. The Office Action states that one of ordinary skill in the art would have recognized the most effective sounds to implement into the alarms issued by the PLD. Unfortunately, this overlooks the fact that the PLD might not generate the claimed sounds or choose the claimed sounds as there is no objective evidence presented to this effect. All that is presented is speculation not supported by objective factual evidence required by the aforementioned case law.

Accordingly, the Office Action fails to make out a prima facie case of proper motivation to modify Welch, as suggested, and fails to make out a prima facie case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection are respectfully requested.

Additional Cited References

Because the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested. If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any

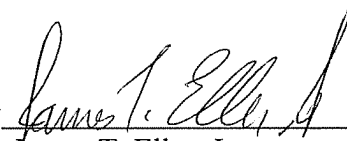
additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly,
extension of time fees.

Date: February 7, 2007

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By



James T. Eller, Jr.

Reg. No.: 39,538

8110 Gatehouse Rd.

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

JTE/RJW/jmb